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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/907,635	08/08/1997	MIYUKI ENOKIDA	35.C10457CON	8513

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EXAMINER
HONG, STEPHEN S

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

H-G

Office Action Summary

Application No.	Applicant(s)
08/907,635	Enokida et al.
Examiner	**Art Unit**
Stephen Hong	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Oct 10, 2001*

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *62-86* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *62-86* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed on 10/10/2001 to the CPA filed 1/22/01 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.

2. Claims 62-86 are pending in this case. Claims 62, 76, 77, and 86 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 62-72, 76-82 and 86 remain rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claim 62, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- input means and decoding means for decoding encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image (col.2, line 54, "The video compression circuit ...compress the video data ...using both interframe and intraframe algorithm ...[and the] video decompression circuit decompresses intraframe-only compressed video data to allow editing");

- encoding means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and

- second encoding means for encoding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.").

As per dependent claims 63-64, Bonomi teaches designating a picture for editing (col.3, lines 1-10)

As per dependent claims 65-69, Bonomi teaches encoding the images in MPEG, which contains the predetermined number of intra-coded pictures (see col.1, lines 25+, "the standard is the MPEG...") and JPEG (col.1, lines 40-45)

As per dependent claim 72, Bonomi discloses **an edition in a time base direction between frames** (col.1, line 52, "Typical editing activities include special effects, titling, mixing, fades and wipes...").

As per dependent claim 70 and 71, Bonomi discloses **displaying the decoded image data** (col.3, line 52, "...decompressed the video data to display the video images on display").

Claims 76-82 and 86 recite substantially similar limitations as claims 62-72, and are similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 73-75 and 83-85 remain rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 73-75, Bonomi teaches the editing features of insertion and deletion of number of pictures. However, Nguyen discloses **animation images displayed in multi-screen displays that are obtained by reducing the frame images** (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ..."). Nevertheless, Bonomi teaches the editing activities including "mixing, fades and wipes" (col.1, line 52), which require manipulating the number of pictures. Therefore, the features would have been obvious to a person of ordinary skill in the art at the time the invention was made in view of Bonomi's suggestions.

Claims 83-85 recite substantially similar limitations as claims 73-75, and are similarly rejected under the same rationale.

Response to Amendment

8. Applicant's arguments filed 10/10/2001 have been fully considered but they are not persuasive.

Applicant argues that the prior art of Bonomi (USPAT 5,577,191 filed in Feb 1994) does not qualify as a valid prior art, since the Applicant's foreign priority application No. 6-

010083 (filed on Jan 31, 1994) predates Bonomi. Applicant then asserts "[i]f the Examiner takes the position that Applicants' '083 priority document does not fully support the independent claims, it is respectfully requested that the particular features alleged not to be supported be individually identified."

In response, Examiner points out the claimed features not supported by the priority document. The present application claims the foreign priority under 35 U.S.C. § 119 based on two Japanese patent applications: application 6-010083 filed 1/31/94 (hereinafter '083) and application 7-007389 filed 1/20/95 (hereinafter '389). Both applications teach the techniques of decoding encoded-video frames for user editing. However, there is a MAJOR difference between the two applications. The JP '083 application only teaches detecting and decoding the intraframe-encoded frames (i.e., the frame is compressed with information within its own frame) for editing. The JP '389 application also teaches detecting and decoding the intraframe-encoded frames, but also teaches decoding the interframe-encoded frames (i.e., the frame is compressed with information from other frames) and converting them into intraframe-encoded frames for editing.

Simply put, the earlier filed JP '083 application does not provide the support for "a) input means for inputting image data encoded by using intra-picture coding and inter-picture coding; b) decoding means for decoding the encoded image data input by said input means" in Claim 62, for example. On page 8 of the amendment, Applicant points to Figures 1 and 2 of the '083 priority document as the support for the above said feature. However, this is in error.

The following is the actually excerpts from the translated '083 document, on page 8, in the last paragraph, which describes the processing in Figure 2:

> First, when the animating image coding data which is inputted and encoded by the MPEG system is designated from the user by using a pointing device such as a mouse ...., the designate animating image coding data is sequentially decoded by the MPEG decoder...[and] an output result is inputted to the JPEG encoder.

Note that in nowhere does it teach decoding the inter-picture images to then be encoded by the intra-picture coding means. Nowhere does it teach that the "interframe" coded images are decoded and encoded. Even if (for the argument sake) it is assumed that both interframe and intraframe coded images are decoded and re-encoded to the intraframe scheme, the '083 document does not teach how it is done. Compare now to the '389 document, it teaches converting the interframe coded images in MPEG video to the intraframe coded scheme by identifying the I, P, and B frames for conversion (page 16, in the second paragraph). Therefore, '083 can not possibly be considered as the enabling priority document for said features claimed in Claim 62, for example, since the claimed matter is disclosed and enabled in the later '389 priority document.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9724 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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Stephen Hong

Primary Examiner

December 28, 2001